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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,174	11/25/2000	Kia Silverbrook	NPA081US	3854

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AUSTRALIA

EXAMINER

GRAHAM, CLEMENT B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/722,174	Applicant(s) SILVERBROOK ET AL.	
	Examiner Clement B. Graham	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-47 remained pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

4. Claims 1-19, 21, 23-24, 26-40, 42-44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perazza patent (5,326,959) in view of Ogawa et al (Hereinafter U.S Patent 5, 608, 874).

The Perazza patent discloses a method of enabling bill payment of bills comprising the steps of providing a person with a bill containing information relating to a payment (col. 11, lines 1-13 receiving indicating data from a sensing device ("i. e, computer") (col. 16, lines 29-54 and col. 11, lines 1822) and identifying at least one parameter relating to the payment (Note abstract and see col. 16, lines 24-54).

Perazza fail to explicitly teach sensing the indicating data relative to a bill.

However Ogawa discloses in one embodiment, the data transmission process is invoked in step, where the uploading process is initiated via Telecommunications Software. In step, Provider connects with ComServer and upon being validated by the methods discussed in the description of FIG. 5, receives clearance to transmit a copy of Provider Data File to Main Processing Section. At this point Provider Data Files that had been placed in Provider's Outgoing Data Box in step are read in step, copies being transmitted in step over Telecommunications Link, to Main Processing Section. In step, Telecommunications Software determines whether a copy of Provider Data File has been transmitted successfully. Successful data transmission is signaled to Main Processing Section by a response produced by the modem protocol. Most standard

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modem protocols including X, Y, and Z modem protocols have internal error checking means to carry out such a signaling process. If Provider Data File has been successfully transmitted, then the Provider Data File duplicate remaining in Outgoing Data Box is "moved" to History Data Box in step, for example by simply renaming the subdirectory. If Provider Data File is not successfully transmitted, then an error appears in Provider Error Log, in step. Data Provider File Management Program is thus completed.9see column 11 lines 17-41).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Perazza to include sensing the indicating data relative to a bill inorder to transfer data and translation such as accounting data from a variety of remote sources and formats.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

7. Claims 20, 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the PCT application WO 99/50787 (XEROX).

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the data being substantially invisible (claims 20 and 45) and the sensing device having a marking nib (claim 41). The XEROX reference teaches the data being substantially invisible (page 8, lines 23-25) and the sensing device having a marking nib (505, page 14, lines 10-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have substantially invisible data so as to interfere with other visible markings on the bill and to

have a sensing device with a nib so that should marks be necessary on the bill, they can be made at the time of reading the bill with the sensing device.

8. Claim 22, is rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the Story patent (5,673,430). The Perazza patent discloses all the elements of the claimed invention, as stated above, except the bill using a mixture of multicast and pointcast communication protocols (claim 22). The Story patent teaches the use of multicast and pointcast communication protocols (col. 3, lines 14-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to use multicast and pointcast communication protocols so as to reduce operating costs.

9. Claims 25 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the Japanese Patent Abstract 10194562 A.

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the binding of a multipage bill (claims 25 and 47). The Japanese patent abstract reference teaches the binding of multiple pages of the bill (Solution portion of Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have a means of binding a bill having multiple pages so that the various pages will remain together and reduce the opportunity for them to become separated.

Conclusion

Response to Arguments

10. Applicant's arguments filed on 01/23/2006 have been fully considered but they are not persuasive for the following reasons.

11. With respect to Applicant's argument on Prima Facie Obviousness, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ* 685, 686 (Fed. Cir. 1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has

at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood*, 28 USPQ2d 1300(Bd. Pat. App &.,4/293 Therefore the combination of reference is proper and the rejection is maintained.

12. In response to Applicant's arguments that prior art of reference fail to teach or suggest" receiving "indicating data" from a sensing device and regarding an identity of the person with being contained in the sensing device" the Examiner disagrees because Applicant" s steps within the claims 1,4-5, are providing, receiving and identifying, However receiving indicating data from a sensing device regarding the identity of the bill and position of the sensing device "does not describes the bill", first "its just receiving indicating data not describing it" and sensing device happens to be " Non functional description" and "regarding the identity of the bill and position still do not describe the data because there are many ways a bill can be identify.

Therefore it obviously clear the teachings of Applicant's claimed invention are addressed within the prior of references applied.

13. The Examiner apologies for misstating in an earlier communication that Perazza and Ogawa fail to teach certain features of Applicants" claims invention, however it is the Applicant's are required to read the references in their entirety.

14. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

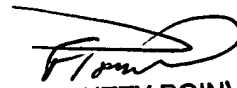
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

May 1, 2006


FRANTZY POINVIL
PRIMARY EXAMINER
Au 3628